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EXAMINER

BROWN, RUEBEN M

ART UNIT PAPER NUMBER

2611

DATE MAILED: 02/04/2003

146

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

08/822,397

Applicant(s)

SCHWAB ET AL.

Examiner

Brown M. Reuben

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 18-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 18-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

1. The Affidavit filed on 12/18/2002 under 37 CFR 1.131 is sufficient to overcome the Hofmann reference.

Response to Arguments

2. Applicant's arguments filed 12/18/2002, with respect to the 112 first paragraph rejection of claim 26-33 have been fully considered, but they are not persuasive. Applicant argues on page 3, that examiner states that, "one or more secondary transmission media is not found in the specification". Examiner respectfully disagrees with applicant's characterization of the instant rejection. In particular, the 112 first paragraph rejection of record is that the specification does not teach "the program including additional information for directing the channel selector to automatically switch, at least temporarily to one or more secondary transmission media", such that the secondary transmission media is different from the first transmission media.

Examiner agrees with applicant that the specification does teach the ability to switch between broadcast-frequency channels and CATV program channels. However, examiner points out that the specification discloses and the originally filed claim 1 recites that "the switching of a particular input being a function of the user defined channel designations". Moreover original

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claim 8 recites that additional channels carry supplemental program information, the system being capable of determining at least one of the additional channels and tuning that channel so as to output the program along with the supplemental information.

Nevertheless, even though original claim 8 teaches automatically switching to another channel to tune to a TV program, it does not explicitly recite that the another channel may be located on a secondary transmission media, different from the first transmission media. Applicant goes on to state on page 3, "clearly to one of ordinary skill in the art, channels on primary vs. secondary transmission will be selected at will, without regard to origin". Examiner respectfully disagrees with applicant's assertion. First of all, it would apparently be logical or obvious to switch to a secondary channel on the same transmission media as the primary channel. Secondly, whether or not it would be obvious to switch to a secondary transmission is not a relevant question to overcome the 112, 1st paragraph rejection. The question of obviousness is used with respect to prior art rejections, not new matter rejections.

In order to overcome the 112, 1st paragraph rejection, applicant must demonstrate that the subject matter recited in the claims was present in the original specification or original claims. Therefore, whether it would have been obvious to practice a recited feature, does not answer the question as to whether the recited feature was described in the specification as to reasonably convey to one of ordinary skill in the art that the applicant possessed the feature at the time the invention was made. Examiner thus maintains the 112, 1st paragraph rejection of claims 26-33.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 23-33 & 39-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Considering claim 26, the recited feature of the instant claim calls for, “transmitting, from a broadcaster to the viewing location, a TV program on a *primary transmission medium*, the program including additional information for directing the channel selector to automatically switch, at least temporarily to one or more *secondary transmission media*, which is not found in the specification, emphasis added.

On page 5 of the specification, it is disclosed that a primary channel may include additional information for directing a second tuner to a secondary channel. However, the specification does not explicitly state that this secondary channel may be on a transmission media different from the primary channel.

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As pointed out above, even though original claim 8 recites automatically switching to another channel to tune to a TV program, it does not explicitly recite that the another channel may be located on a secondary transmission media, different from the first transmission media.

Considering claim 23, the instant claim requires that the information for automatically switching the TV channel to an alternate transmission medium is downloaded from a computer. Therefore the claim 23 is analyzed in the same manner as claim 26.

Considering claims 24 & 25, and 39-40, the amended claimed features require data transmitted continuously with a TV program or at the initiation of a TV program, which automatically switches the instant TV program from a first transmission medium, to an alternate transmission medium. Since claims 24 & 25 require that the switching to a different transmission medium is in response to transmitted data, instead of a user selection, the instant claims are treated in the same manner as claim 26.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 18-19, 21 & 34-35 & 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Olesen, (U.S. Pat # 4,866,787).

Considering amended claim 18, Olesen teaches that a user is enabled to choose between receiving programming from the RF antenna, CATV or satellite TV inputs, see Fig. 1 & col. 2, lines 53-58. The claimed feature of automatically changing to an alternative transmission medium at a TV viewer location, comprising the step of entering at the viewer location, information regarding a viewing preference is broad enough to read on a viewer changing the source input at a multisource receiver, which is met by col. 3, lines 40-60; col. 6, lines 54-59 & col. 8, lines 21-34.

Clearly, the different TV transmission media providers in Olesen offer overlapping channels, such as for instance ESPN, CNN or MTV would be received over both standard CATV and satellite TV inputs. Thus, Olesen inherently enables a customer to tune to a particular channel to receive a specific TV program from a first TV provider, and then switch to a second service provider.

Considering claims 19 & 37, Olesen teaches that the gateway receives CATV channels/programs, (Fig. 1 & col. 3, lines 40-60).

Considering claim 21, Reiter discloses using a remote-control unit 44 for customer input, col. 8, lines 21-34.

Considering claim 34, the claimed TV system, comprising automatically changing the source of a transmission medium, in response to a user request is met by the disclosure of Olesen, (col. 6, lines 55-59 & col. 8, lines 21-34).

Considering claim 35, the claimed feature of entering descriptive information by a viewer is broad enough to read on a user entering a channel number, which causes the tuner to change the channel, and is inherently included in Olesen.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20, 22, 36 & 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olesen.

Considering claims 20 & 38, Olesen discusses transmission of TV data from TV antenna, CATV and satellite TV, but does not explicitly state that any of transmission are in digital form.

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Nevertheless, Official Notice is taken that at the time the invention was made, that the transmission of TV data in digital form was well known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Olesen and transmit TV data in digital format, at least for the known improvement of delivery of more programming on the same 6 MHz bandwidth due to compression.

Considering claims 22 & 36, Olesen does not disclose the use of an on-screen program guide. Official Notice is taken that at the time the invention was made, electronic program guide (EPG) technology was very well known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Olesen with the well known feature of an EPG, at least for the desirable benefit of enabling user selection of programming in a more organized manner.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Reiter Teaches a gateway device at a subscriber premise that receives UHF/VHF broadcasts, as well as CATV inputs. Reiter also discloses EPG usage.

B) Maruoka Teaches reception of TV channels from three different satellite antennas, at a subscriber's premise.

B) Yokota Teaches reception from an RF antenna and CATV medium, at a subscriber's premise.

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Any response to this action should be mailed to:

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or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

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*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the
organization where this application or proceeding is assigned is (703) 872-9314 for regular
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown


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